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SUBJECT Substitutue Brief (09/998,392)

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MESSAGE

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TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	09/998,382
Filing Date	11/29/2001
First Named Inventor	Bhupesh Gupta
Art Unit	2178
Examiner Name	Gautam Sain
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- [ ] Response to Missing Parts/ Incomplete Application
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- [ ] Drawing(s)
- [ ] Licensing-related Papers
- [ ] Petition
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Remarks
Substitute Appeal Brief.

- [ ] After Allowance communication to Technology Center (TC)
- [ ] Appeal Communication to Board of Appeals and Interferences
- [✔] Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
- [ ] Proprietary Information
- [ ] Status Letter
- [ ] Other Enclosure(s) (please identify below):

Supplemental Amendment.

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Volel Emile
Signature	
Date	09/05/2006

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Application of:
    Bhupesh Gupta

Serial No: 09/998,392

Filed: 11/29/2001

Title: APPARATUS AND METHOD
OF HIGHLIGHTING CATEGORIZED
WEB PAGES ON A WEB SERVER

:
:
: Before the Examiner:
:   Gautam Sain
:
: Group Art Unit: 2176
:
: Confirmation No.: 7315
:
:

SUBSTITUTE APPEAL BRIEF

Assistant Commissioner of Patents
Washington, D. C. 20231

Sir:

    This is a response to a Notification of Non-Compliant Appeal Brief received on August 8, 2006.

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<u>BRIEF FOR APPLICANTS – APPELLANTS</u>

(i)

<u>Real Party in Interest</u>

The real party in interest is International Business Machines Corporation (IBM), the assignee.

(ii)

<u>Related Appeals and Interferences</u>

There are no other appeals or interferences known to appellants, appellants' representative or assignee, which will directly affect or be directly affected by or have a bearing on the Board's decision In the pending appeal.

(iii)

<u>Status of Claims</u>

All claims in the Application (i.e., Claims 1 – 15) have been finally rejected.

(iv).

<u>Status of Amendment</u>

No amendment was filed after the Final Rejection of January 11, 2006.

(v)

<u>Summary of Claimed Subject Matter</u>

The present Application contains four sets of claims of the same scope. The first set (Claims 1 – 3) Is directed toward method claims, the second set (Claims 4 – 6) toward computer program product, the third set (Claims 7 – 9) toward apparatus and the fourth set (Claims 10 – 12) toward system. The Application also contains three independent method claims of different scopes: method Claims 13, 14 and 15.

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     The invention, as claimed in independent Claims 1, 4, 7, and 10, provides a manner of highlighting categorized Web pages on a Web server. Accordingly, when there is a list of Web pages on a server arranged in categories, a comparison is made between the Web pages in the list and Web pages in a bookmark folder on a user's computer system. All the Web pages in the list that are the same as the Web pages in the bookmark folder will be highlighted (see page 21, lines 28 – 32, page 22, lines 1 – 16 as well as Fig. 17).

     The code means plus function of Claims 4 – 6 are the steps outlined in Fig. 17 as well as in the text on page 22, lines 1 – 16 where as the means plus functions of Claims 7 – 9 are the steps outlined in Fig. 17 as well as in the text on page 22, lines 1 – 16 processed by either processor 202 or 204 or both.

     The invention as claimed in independent Claims 13 - 15 provides a method of highlighting Web pages arranged in categories on a server. When a user accesses a Web page on the server on which Web pages arranged in categories are displayed, Uniform Resource locators (URLs) of all Web pages in a bookmark folder stored either on a client computer system or on the server are retrieved. Note that if the bookmark folder is stored on the server it is enabled to be accessed by a plurality of users. In any case, the URLs of the bookmarked Web pages with URLs of the Web pages in the categories are compared to each other. All the Web pages in the categories displayed on the Web page that have the same URLs with the bookmarked Web pages are then highlighted (see page 21, line 28 to page 22, line 16 as well as Fig. 17).

(vi)

Grounds of Rejection to be Reviewed on Appeal

Whether the claims were properly rejected under 35 USC 103(a) as being unpatentable over Nation in view of Burke.

(vii)

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<div align="center">Arguments</div>

Whether Claims 1 – 12 were properly rejected under 35 USC 103(a) as being unpatentable over Nation In view of Burke

In considering a Section §103 rejection, the subject matter of the claim "as a whole" must be considered and analyzed. In the analysis, it is necessary that the scope and contents of the prior art and differences between the art and the claimed invention (taken as a whole) be determined. *Graham v. John Deere Co.,* 383 U.S. 1 (1966).

The Examiner admitted that Nation does not teach the step of *comparing bookmarked Web pages in a bookmark folder with Web pages arranged in categories on a server* but asserted that Burke does provide such step. Applicants respectfully disagree.

Burke purports to provide a system for storing bookmark files in a remote location. According to Burke, a bookmark file that is stored on a local computer system (i.e., a system that is being used by a user) may also be stored remotely for anytime availability including when the local computer system is inoperative. When a bookmark file is being stored at the remote location by the user and if the user had already stored a bookmark file at the remote location, the bookmarks in the file being stored and the bookmarks in the previously stored file may be merged together. The bookmarks in the bookmark file being stored may be stored in categories in which bookmarked pages from the previously stored bookmark file are stored. The categories may be in accordance with a master set of theme and topic codes. In this case, individual bookmarked pages from the file being stored will have been given a topic and theme code <u>by the local system</u>. After storing the bookmark file at the remote location, the user may at anytime download the bookmark file to any local system.

However, Burke does not teach, show or so much as suggest the step of *comparing Web pages that have been bookmarked In a bookmark folder*

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with the Web pages in the categories. Rather, Burke teaches that a user may upload a bookmark folder on a remote system.

Nonetheless, even if Burke did teach the above comparing step as asserted by the Examiner, combining the teachings of Burke with those of Nation would not teach the invention.

Nation teaches a method of indicating when clickable image links of hypertext image maps of a computer web browser has been traversed. According to Nation, various web browsing software packages or other hypertext software packages keep a history of various nodes or links that a user has previously visited. This is done to indicate whether a node or link has already been visited anytime thereafter. The indication usually entails changing some feature of the text, e.g., color, font, underline, etc. But, until the disclosure of Nation, the indication only applied to textual links of alphanumeric characters. Nation then provides a method to also indicate whether a clickable image has already been visited.

Specifically, when a clickable graphical image is to be displayed, it is determined, using a history of image links that have been previously visited, whether the clickable image has been traversed. If so, some sort of a marker is used to indicate that the clickable image has already been traversed.

However, Nation does not teach, show or suggest the steps of *highlighting all Web pages in categories on a server that are the same as bookmarked Web pages in a bookmark folder on a local system* as claimed.

Consequently, neither Nation nor Burke, alone or in combination, teaches the claimed invention.

Whether independent Claims 13 – 15 were properly rejected under 35 USC 103(a) as being unpatentable over Nation in view of Burke

In addition to the steps in independent Claims 1, 4, 7 and 10, independent Claims 13, 14 and 15 contain each additional step of accessing a Web page on the server on which Web pages arranged in categories are displayed and

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additional step of retrieving Uniform Resource locators (URLs) of all Web pages in a bookmark folder, the bookmark folder being stored either on a client computer system or on the server, the bookmark folder, if stored on the server, being enabled to be accessed by a plurality of users. Since, as mentioned above, neither Nation nor Burke, alone or in combination teaches the steps in Claims 1 – 12, Applicants submit that likewise they do not teach the invention as claimed in independent Claims 13 – 15.

Nonetheless, please note that nowhere in their disclosure does either Nation or Burke mention the additional steps reproduced above.

Hence, Applicants respectfully request withdrawal of the rejection and passage to issue of the claims.

Respectfully Submitted

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(VII)

Claims Appendix

1.   (Previously presented) A computer implemented method of highlighting
        Web pages arranged in categories on a server comprising the steps of:

        comparing bookmarked Web pages in a bookmark folder with the Web
        pages in the categories; and

        highlighting all the Web pages in the categories that are the same as the
        bookmarked Web pages.

2.   (Previously presented) The computer implemented method of Claim 1
        wherein the bookmark folder is on a client.

3.   (Previously presented) The computer implemented method of Claim 1
        wherein the bookmark folder is on a server.

4.   (Original) A computer program product on a computer readable medium
        for highlighting Web pages arranged in categories on a server comprising:

        code means for comparing bookmarked Web pages in a bookmark folder
        with the Web pages in the categories; and

        code means for highlighting all the Web pages in the categories that are
        the same as the bookmarked Web pages.

5.   (Previously presented) The computer program product of Claim 4 wherein
        the bookmark folder is on a client.

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6.   (Previously presented) The computer program product of Claim 4 wherein the bookmark folder is on a server.

7.   (Previously presented) A computer implemented apparatus for highlighting Web pages arranged in categories on a server comprising:

        means for comparing bookmarked Web pages in a bookmark folder with the Web pages in the categories; and

        means for highlighting all the Web pages in the categories that are the same as the bookmarked Web pages.

8.   (Previously presented) The computer implemented apparatus of Claim 7 wherein the bookmark folder is on a client.

9.   (Previously presented) The computer implemented apparatus of Claim 7 wherein the bookmark folder is on a server.

10.   (Original) A computer system for highlighting Web pages arranged in categories on a server comprising:

        at least one memory device for storing code data; and

        at least one processor for processing the code data to compare bookmarked Web pages in a bookmark folder with the Web pages in the categories and to highlight all the Web pages in the categories that are the same as the bookmarked Web pages.

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11. (Previously presented) The computer system of Claim 10 wherein the bookmark folder is on a client.

12. (Previously presented) The computer system of Claim 10 wherein the bookmark folder is on a server.

13. (Previously presented) A computer implemented method of highlighting Web pages arranged in categories on a server comprising the steps of:

accessing a Web page on the server on which Web pages arranged in categories are displayed;

retrieving Uniform Resource locators (URLs) of all Web pages in a bookmark folder, the bookmark folder being stored either on a client computer system or on the server, the bookmark folder, if stored on the server, being enabled to be accessed by a plurality of users;

comparing the URLs of the bookmarked Web pages with URLs of the Web pages in the categories; and

highlighting all the Web pages in the categories displayed on the Web page that have the same URLs with the bookmarked Web pages.

14. (previously presented) A computer implemented method of indicating Web pages on a server that have already been bookmarked on a remote computer system comprising the steps of:

accessing a Web site on the server on which Web pages arranged in categories are displayed;

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retrieving Uniform Resource locators (URLs) of all bookmarked Web pages in a bookmark folder, the bookmark folder being stored on the remote computer system and being enabled to be viewed by a plurality of users, however, only bookmarked Web pages in the bookmark folder for which a user has access permission may be accessed by the user;

comparing the URLs of the bookmarked Web pages with URLs of the Web pages in the categories; and

highlighting all the Web pages in the categories displayed on the Web page that have the same URLs with the bookmarked Web pages.

15.   (previously presented) A computer implemented method of indicating Web pages on a server that have already been bookmarked on a local computer system comprising the steps of:

accessing a Web site on the server on which Web pages arranged in categories are displayed;

retrieving Uniform Resource locators (URLs) of all bookmarked Web pages in a bookmark folder, the bookmark folder being stored on the local computer system;

comparing the URLs of the bookmarked Web pages with URLs of the Web pages in the categories; and

highlighting all the Web pages in the categories displayed on the Web site that have the same URLs with the bookmarked Web pages.

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(Ix)

Evidence Appendix

No evidence was submitted pursuant to 37 C.F.R. §§ 1.130, 1.131 and 1.132 nor was there any evidence entered by the Examiner relied upon by Appellants in this appeal.

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(x)

Related Proceedings Appendix

There are no decisions rendered by a court or the Board that would have
a bearing on the Board's decision in the pending appeal.

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